The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 2-7 and 10-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Maekawa et al. in view of Maniatis et al. (pages 226-227, 412-413, 422, and 518 of record with 228 only newly cited) and further in view of Sudoh et al. (R) and Sudoh et al. (T), and Oikawa et al. and Vlasuk et al., and is repeated for the same reasons of record as found in the Official action mailed 4/21/94.

Applicant's arguments filed 9/21/94 have been fully

considered but they are not deemed to be persuasive. The accompanying declaration filed 9/21/94 has not been considered since it is unexecuted. Therefore, the 9/21/94 declaration is not before the examiner. However, note that the remarks in applicants 9/21/94 arguments concern the issues discussed in the 9/21/94 declaration. These issues were addressed in the examiner's arguments found after the section 103 rejection mailed 4/21/94. Even if the 9/21/94 declaration were properly executed, the position taken in the arguments set forth in the 4/21/94 Official action as cited above would be maintained for the reasons argued therein, albeit that applicants interpret the prior art differently.

On page 6 of applicants 9/21/94 remarks, they argue that the citation of Maniatis et al. is similar to the previously cited Suggs et al. This is not agreed with since the newly cited page 228 of Maniatis is concerned, as argued herein and in the previous action, isolation of a corresponding cDNA using a cDNA as a probe. This is the current basis of the instant rejection, rather than the development of oligo probes based on a known amino acid sequence. Suggs was withdrawn in the instant version of the section 103 rejection since the technology of Suggs is not applicable here. The instant rejection is based on using the known pBNP cDNA as a probe to isolate the corresponding human BNP cDNA.

On page 7 of said applicants' remarks, applicants continue

to attack Maniatis arguing that Maniatis requires that the amino acid sequence be known and that "without absolute assurance that there will be at least one probe which is exactly complementary to the target sequence...success cannot be achieved." Firstly note that absolute success is not the standard applicable to a section 103 rejection, but rather, a reasonable expectation. Secondly, the instant rejection is based on using the known pBNP cDNA as a probe to isolate the instant hBNP cDNA.

Applicants argue further that Seilhamer et al. teach away form the instant rejection. However, this has been addressed previously, and it is repeated herein:

"[e]ssentially it remains applicants position that Seilhamer et al. (U.S. Patent No. 5,114,923) teaches away from the instant invention since Seilhamer teaches that they failed to isolate the hBNP cDNA utilizing the Seilhamer pBNP cDNA as disclosed. However, this outcome is not surprising since as per Experiment 5 found in col. 23, Seilhamer used the putative cDNA as shown in Figure 1 which contained an unprocessed intron, and thus not a true and/or a complete cDNA. Even though this putative cDNA was used to screen a human genomic library, which contains introns, the appropriate probe to use for this screening would have been the complete genomic pBNP gene and not a incomplete cDNA since the expectation would have been that the genomic sequence would contain other introns or other intervening sequences. Therefore, it is not surprising that Seilhamer failed to isolate the hBNP genomic clone. This being the expectation based on the experiment in Example 5, Seilhamer does not teach away from using the completely processed porcine BNP gene (a true or complete cDNA devoid of introns or intervening sequences) as a probe, this being a routine method of cDNA isolation (as per Maniatis for example), and as was done for the evolutionarily related ANP cDNAs."

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner LeGUYADER at telephone number (703) 308-0447.

JStone

JACQUELINE STONE
PRIMARY EXAMINER
ART UNIT 1804

John L. LeGUYADER
January 16, 1995